UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,768	07/13/2001	Florence L'Alloret	210578US0	1465

22850 7590 03/17/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
YOON, TAE H	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/903,768	L'ALLORET ET AL.	
	Examiner	Art Unit	
	Tae H Yoon	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) *29-33* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28 and 34-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's election with traverse of Group I in is acknowledged. However, no particular traversal is given other than a statement regarding the claim 33, and thus the election is treated without traverse.

Applicant states that claim 33 is a composition claim and thus it should be included in Group I. However, said claim 33 and Group I are related as combination (genus) and subcombination (species), and thus said claim 33 could form other Group III, but included in Group II.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This is a duplicate of claim 40.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 and 14-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bollens et al (US 5,591,449).

Bollens et al teach oil-in water cosmetic and pharmaceutical emulsion compositions comprising an oil, an amphiphilic lipid and a polymer in examples. The use of an additional surfactant is taught at col. 5, lines 16-26. The vesicles (oil globules) are between 20 and 500 nanometer, in size, col. 7, lines 43-45. Various gelling agents such as hydroxyethyl cellulose and their addition to the emulsion is taught at col. 8, lines 21-37. The composition of Bollens et al inherently possesses the recited viscosity and turbidity. Polymers recited in claims 6-11 are optional components when said claims 6-11 are combined with claim 1. Various compositions and active compounds taught at col. 4, lines 28-35 and col. 8, lines 5-20 inherently meet the recited ophthalmic vehicle of claims 21 and 27 absent further limitation.

Thus, the instant invention lacks novelty.

Claims 1-28 and 34-42 are rejected under 35 U.S.C. 103(a) as obvious over Bollens et al (US 5,591,449) in view of Friedman et al (US 6,004,566), Binns et al (US

6,287,377), Bernecker et al (US 6,569,414) or Suzuki et al (US 6,432,439), and further in view of FR 2 787 027 or Simonnet et al (US 6,274,150, 6,375,960 or 6,464,990).

Rejection is maintained for reason of record and following response.

In O/W of Bollens et al, the oil is present in vesicles and the vesicles are present in water, and thus the size of the oil is smaller than that of vesicles (20-500 nm). Bollens et al teach the same components as claimed in the instant original claims, and thus meets the instant invention (before cancellation of celluloses).

Bollens et al teach O/W emulsion with nano-size vesicles which meets the instantly recited nanoemulsion since said nanoemulsion is known as an emulsion with a few to a few hundred nm size, not a micron size (microemulsion, thousand or more nm size). Note that the examples (col. 13, lines 3-5, for example) of Bollens et al teach a high mechanical shearing which is used in obtaining a nanoemulsion as in the instant invention.

Thus, the use of the art well known gelling or thickening agent as taught by Friedman et al (col. 6, lines 23-25), Binns et al (col. 8, lines 15-27), Bernecker et al (col. 4, lines 5-8) and Suzuki et al in Bollens et al is a *prima facie* obviousness.

Bollens et al teach thickening agents and thus the composition is thickened. The thick vesicles and thick cream taught in the examples of Bollens et al would meet the instantly recited increased viscosity.

Claims 1-12, 14-16,18-28 and 36-42 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Simonnet et al (US 6,464,990).

Rejection is maintained for reason of record and following response.

Contrary to applicant's assertion, Simonnet et al teach the instant ratio of oily phase (2-40%) and amphiphilic lipid (0.01-5%) at col. 3, lines 26-31 and col. 5, lines 20-25. The composition of Simonnet et al is inherently thickened by the claimed factor.

Claims 1-28 and 34-42 are rejected under 35 U.S.C. 103(a) as obvious over Simonnet et al (US 6,274,150 or 6,375,960 or 6,464,990) or FR 2787027 in view of Friedman et al (US 6,004,566), Binns et al (US 6,287,377), Bernecker et al (US 6,569,414) or Suzuki et al (US 6,432,439).

Rejection is maintained for reason of record and following response.

Contrary to applicant's assertion, the primary references teach employing synthetic polymers as a gelling or thickening agent, and thus, the use of the art well known gelling or thickening agent as taught by the secondary references is a *prima facie* obviousness.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tae H Yoon
Primary Examiner
Art Unit 1714

THY/March 9, 2004